

***Remarks***

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing Amendment to the Claims, claims 1-26 are pending in the application, of which claims 1, 10, and 17 are independent. By the foregoing Amendment, claim 21 is sought to be amended. No new matter is embraced by this amendment and its entry is respectfully requested. Based on the above Amendment and the remarks set forth below, it is respectfully requested that the Examiner reconsider and withdraw all outstanding objections and rejections.

***Information Disclosure Statement***

The Examiner, on page 2 of the Office Action, has indicated that the information disclosure statement filed 11/20/2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Applicant has attached the information disclosure statement filed on 11/20/2001 with a legible copy of the cited reference therein to be considered by the Examiner.

***Claim Objections***

The Examiner, on page 2 of the Office Action, has objected to claim 21 because of the following informalities: "after user the registration." Applicant has amended claim 21 to read "after user registration." Applicant respectfully requests that the Examiner withdraw the objection to claim 21.

***Rejection under 35 U.S.C. § 103***

The Examiner, on page 2 of the Office Action, has rejected claims 1, 2, and 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,654,779 to Tsuei and in view of U.S. Patent No. 6,731,731 to Ueshima. Applicant respectfully traverses this rejection. Based on the remarks set forth below, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

With respect to independent claim 1, the Examiner states that Tsuei substantially teaches Applicant's invention. Applicant respectfully disagrees. Tsuei does not teach all of the elements recited in claim 1. For example, Tsuei does not teach or suggest at least the following elements: "receive an electronic mail message from a sender that specifies the user's electronic mail account as a recipient;" and "forward the electronic mail message to the new electronic mail address."

Unlike the present invention, Tsuei's E-mail Address Management System (EAMS) does not "receive an electronic mail message from a sender that specifies the user's electronic mail account as a recipient." Contrary to the present invention, the EAMS of Tsuei receives a query from the sender's ISP to find out if there is an address change registered with the EAMS for the old system. *Tsuei*, col. 7, lines 36-39. The EAMS will then search the database to see if a new address has been registered. *Id.* at col. 7, lines 39-41. If a new address is found for the old address, the EAMS sends the new address to the sender's ISP. *Id.* at col. 7, lines 41-43. Thus, unlike the present invention, the EAMS never receives the electronic mail message. Instead, the EAMS receives a query from the sender's ISP to inquire as to whether a forwarding address has been registered with the EAMS.

Unlike the present invention, Tsuei's EAMS does not "forward the electronic mail message to the new electronic mail address." As indicated above, with Tsuei, if the EAMS finds that a forwarding address has been registered with the system, the EAMS sends the new address (forwarding address) to the sender's ISP. *Tsuei*, col. 7, lines 41-43. Then, the sender's ISP forwards the electronic mail message to the intended recipient via the new ISP and notifies the sender of the user's new address. *Id.* at col. 7, lines 43-46. Thus, contrary to the present invention, the EAMS never receives the electronic mail message, and therefore, cannot forward the electronic mail message to the new electronic mail address.

The Examiner also states, and Applicant respectfully agrees, that Tsuei does not teach Applicant's element to "send a confirmation electronic mail with a required password to the user." The Examiner further states that this element is taught by Ueshima.

Applicant respectfully disagrees. Ueshima does not solve the deficiencies of Tsuei. That is, Ueshima does not teach or suggest Applicant's elements to "receive an electronic mail message from a sender that specifies the user's electronic mail account as a recipient;" and "forward the electronic mail message to the new electronic mail address."

Furthermore, unlike the present invention, the password that is transmitted to the user of the service in Ueshima is for registering a telephone, not an email forwarding address. *Ueshima*, Abstract; col. 3, line 34 – col. 4, line 52.

Thus, for at least the above reasons, Applicant respectfully submits that claim 1, and the claims that depend therefrom (claims 2-9), are patentable over the cited references.

Thus, neither Tsuei nor Ueshima, separately or in combination, teach or suggest Applicant's claimed invention as recited in independent claim 1. For at least the reasons stated above, claim 1, and the claims that depend therefrom, are patentable over the cited references. Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 1, and the claims that depend therefrom (claims 2-9).

The Examiner, on page 5 of the Office Action, has rejected claims 3, 4, and 5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,654,779 to Tsuei, U.S. Patent No. 6,731,731 to Ueshima and in view of U.S. Patent Application Publication No. 2002/0138581 to MacIntosh *et al.* (hereinafter "MacIntosh"). Applicant respectfully traverses this rejection. Based on the remarks set forth below, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Claims 3, 4, and 5 depend from independent claim 1 and are patentable over Tsuei and Ueshima for at least the reasons stated above. Furthermore, MacIntosh does not teach or suggest all of the features missing from Tsuei and Ueshima. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of dependent claims 3, 4, and 5.

The Examiner, on page 7 of the Office Action, has rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,654,779 to Tsuei, U.S. Patent No. 6,731,731 to Ueshima and in view of U.S. Patent No. 6,832,246 to Quine.

Applicant respectfully traverses this rejection. Based on the remarks set forth below, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Claim 6 depends from independent claim 1 and is patentable over Tsuei and Ueshima for at least the reasons stated above. Furthermore, Quine does not teach or suggest all of the features missing from Tsuei and Ueshima. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of dependent claim 6.

The Examiner, on page 7 of the Office Action, has rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,654,779 to Tsuei, U.S. Patent No. 6,731,731 to Ueshima and in view of U.S. Patent No 5,937,161 to Mulligan *et al.* (hereinafter "Mulligan"). Applicant respectfully traverses this rejection. Based on the remarks set forth below, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Claims 7 and 8 depend from independent claim 1 and are patentable over Tsuei and Ueshima for at least the reasons stated above. Furthermore, Mulligan does not teach or suggest all of the features missing from Tsuei and Ueshima. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of dependent claims 7 and 8.

The Examiner, on page 9 of the Office Action, has rejected claims 10-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,654,779 to Tsuei and in view of U.S. Patent No. 6,731,731 to Ueshima, U.S. Patent No 5,937,161 to Mulligan *et al.* (hereinafter "Mulligan") and U.S. Patent Application Publication No. 2002/0138581 to MacIntosh. Applicant respectfully traverses this rejection. Based on the remarks set

forth below, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

With respect to independent claim 10, Tsuei does not teach or suggest at least the following elements of Applicant's claimed invention:

- receive an electronic mail message from a sender that indicates the user's electronic mail account as a recipient;
- forward the electronic mail message to the new electronic mail address; and
- dispatch the electronic mail message to the user's electronic mail account, if the new electronic mail address is not found.

For the same reasons as indicated above with respect to claim 1, Tsuei's EAMS does not "receive the electronic mail message from a sender that indicates the user's electronic mail account as a recipient" or "forward the electronic mail message to the new electronic mail address." Instead, Tsuei's EAMS receives a query from the sender's ISP and sends the new electronic mail address to the sender's ISP to enable the sender's ISP to forward the electronic mail message. *Tsuei*, col. 7, lines 36-46.

Tsuei's EAMS also does not teach or suggest to "dispatch the electronic mail message to the user's electronic mail account, if the new electronic mail address is not found." Instead, Tsuei's EAMS notifies the sender's ISP that the new electronic mail address was not found, and the sender's ISP then notifies the sender via e-mail that the message was undeliverable to the old address and that a forwarding address was not provided. *Tsuei*, col. 7, lines 46-52. In fact, Tsuei's EAMS does not even receive the electronic mail message to the user's electronic mail account, and therefore, cannot dispatch the electronic mail message.

The Examiner also states, and Applicant respectfully agrees, that Tsuei does not teach Applicant's element to "send a confirmation electronic mail with a required password to the user." The Examiner further states that this element is taught by Ueshima.

Applicant respectfully disagrees. Ueshima does not solve the deficiencies of Tsuei. That is, Ueshima does not teach or suggest Applicant's elements to "receive an electronic mail message from a sender that specifies the user's electronic mail account as a recipient;"; "forward the electronic mail message to the new electronic mail address;"; and "dispatch the electronic mail message to the user's electronic mail account, if the new electronic mail address is not found."

Furthermore, unlike the present invention, the password that is transmitted to the user of the service in Ueshima is for registering a telephone, not an email forwarding address. *Ueshima*, Abstract; col. 3, line 34 – col. 4, line 52.

The Examiner also states, and Applicant agrees, that Tsuei does not teach or suggest Applicant's element to "dispatch the electronic mail message to the user's electronic mail account, if the new electronic mail address is not found." The Examiner further states that this element is taught by Mulligan. Applicant respectfully disagrees.

Unlike the present invention, Mulligan teaches that if the subscriber database analyzer does not find a match, the message is forwarded to a user-specified default delivery address, not the user's electronic mail account. *Mulligan*, col. 7, lines 21-25.

The Examiner also states, and Applicant agrees, that Tsuei does not teach or suggest Applicant's element to "make available an electronic mail address of the sender to the user." The Examiner further states that this element is taught by MacIntosh

because MacIntosh teaches in paragraphs [0088] and [0093] that the user can receive an email from a sender and the user can send a reply email to the sender. Applicant respectfully disagrees.

In MacIntosh, the original sender's email address is replaced with a reply-encoding to create an encoded reply address before the email is sent to the user. *MacIntosh*, paragraphs [0087] and [0088]. When the user sends a reply email, the reply email is addressed to the encoded reply address. *MacIntosh*, paragraph [0093]. Thus, unlike the present invention, the electronic mail address of the sender is not made available to the user. Instead, the user is given an encoded reply address to mask the sender's original email address.

Thus, for at least the above reasons, Applicant respectfully submits that claim 10, and the claims that depend therefrom (claims 11-16), are patentable over the cited references.

Independent claim 17 includes similar elements to those recited in independent claim 10. Thus, for at least the reasons stated above, claim 17, and the claims that depend therefrom (claims 18-26), are patentable over the cited references.

Thus, neither Tsuei nor Ueshima nor Mulligan nor MacIntosh, separately or in combination, teach or suggest Applicant's claimed invention as recited in independent claims 10 and 17. For at least the reasons stated above, claims 10 and 17, and the claims that depend therefrom are patentable over the cited references. Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 10 and 17, and the claims that depend therefrom (claims 11-16 and 18-26, respectively).



The Examiner, on page 13 of the Office Action, has rejected claims 17-20, 22, 23, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,654,779 to Tsuei, U.S. Patent No 5,937,161 to Mulligan *et al.* (hereinafter "Mulligan") and in view of U.S. Patent Application Publication No. 2002/0138581 to MacIntosh. Applicant respectfully traverses this rejection. For the same reasons as stated above with respect to independent claim 10, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

The Examiner, on page 18 of the Office Action, has rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,654,779 to Tsuei, U.S. Patent No 5,937,161 to Mulligan *et al.* (hereinafter "Mulligan"), U.S. Patent Application Publication No. 2002/0138581 to MacIntosh, and in view of U.S. Patent No. 6,731,731 to Ueshima. Applicant respectfully traverses this rejection. Based on the remarks set forth below, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Claim 21 depends from independent claim 17 and is patentable over Tsuei, Mulligan, and MacIntosh for at least the reasons stated above. Furthermore, Ueshima does not teach or suggest all of the features missing from Tsuei, Mulligan, and MacIntosh. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of dependent claim 21.

The Examiner, on page 19 of the Office Action, has rejected claim 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,654,779 to Tsuei, U.S. Patent No 5,937,161 to Mulligan *et al.* (hereinafter "Mulligan"), U.S. Patent Application Publication No. 2002/0138581 to MacIntosh, and in view of U.S. Patent No. 6,832,246 to

Quine. Applicant respectfully traverses this rejection. Based on the remarks set forth below, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Claim 24 depends from independent claim 17 and is patentable over Tsuei, Mulligan, and MacIntosh for at least the reasons stated above. Furthermore, Quine does not teach or suggest all of the features missing from Tsuei, Mulligan, and MacIntosh. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of dependent claim 24.

***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all currently outstanding objections and rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Response is respectfully requested.

Respectfully submitted,

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Dated: June 13, 2005

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